

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/670,486 Confirmation No. 8001
Applicant : DANNY BILBY, et al.
Filed : September 25, 2003
TC/A.U. : 2143
Examiner : Nguyen, Phouc H.
Docket No. : 199-0018US-D
Customer No. : 29855
Title : SYSTEM AND METHOD OF MONITORING VIDEO AND/OR AUDIO
CONFERENCING THROUGH A RAPID-UPDATE WEBSITE

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed in response to the Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) mailed March 06, 2009. A fee in compliance with 37 C.F.R. 1.18(f) accompanies this request. Applicant believes that no additional fees are due in connection with this response. However, should any fees or refunds be due, the Office is authorized to charge or credit such fees or refunds to Deposit Account No. 501922, referencing attorney docket number 199-0018US-D.

Remarks begin on page 2 of this paper.

REMARKS

Applicants have received a Notice of Allowance and Fees Due and a Determination of Patent Term Adjustment under 35 U.S.C. 154(b), each with a mail date of March 06, 2009, for the above referenced application. The calculated Patent Term Adjustment (PTA) is indicated as 1053 days. However, Applicants believe the calculated term adjustment should be 1531 days rather than the 1053 days indicated for the following reasons.

As currently codified, 35 U.S.C. § 154(b) provides three guarantees of patent term, two of which are at issue here. The first is found in subsection (b)(1)(A), the "[g]uarantee of prompt Patent and Trademark Office response." It provides a one-day extension of patent term for every day that issuance of a patent is delayed by a failure of the PTO to comply with various enumerated statutory deadlines: fourteen months for a first office action; four months to respond to a reply; four months to issue a patent after the fee is paid; and the like. *See* 35 U.S.C. § 154(b)(1)(A)(i)-(iv). Periods of delay that fit under this provision are called "A delays" or "A periods." The second provision is the "[g]uarantee of no more than 3-year application pendency." Under this provision, a one-day term extension is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO. ¹ *See* 35 U.S.C. § 154(b)(1)(B). The period that begins after the three-year window has closed is referred to as the "B delay" or the "B period". ("C delays," delays resulting from interferences, secrecy orders, and appeals, are similarly treated but were not involved in the patent applications underlying this suit.)

Wyeth v. Dudas, Civ. Action No. 1:07-cv-1492-JR, 2008 WL 4445642 D.D.C.

The pertinent dates for calculating the PTA for this case are as follows:

- 1) 9/25/2003 Application filing date;
- 2) 9/25/2006 Three years from filing (start of B time calculation);
- 3) 11/14/2007 Mailing date of first Office Action;

- 4) 10/9/2008 Notice of Appeal with Request for Pre-Appeal Conference;
- 5) 3/6/2009 Mailing date of Notice of Allowance.

There are several categories of time calculation set forth in 37 C.F.R. 1.703 under subheadings a-g. The pertinent subheading in this instance are “a” (A-Time) and “b” (B-Time). Applicant notes that A-Time and B-Time are not allowed to overlap.

A-Time Calculation

The time period set forth under 37 C.F.R. 1.703(a), A-Time, allows fourteen months from the filing date for the Office to issue a first Office Action. The 14 month date in this case was 11/25/2004 and the first office action was not mailed until 11/14/2007. As noted above, A-Time and B-Time cannot overlap. Therefore, because the B-Time began accruing on 9/25/2006 the A-Time allocated before the first Office Action is calculated as the duration between 11/25/2004 (14 month date) and 9/25/2006 (B-time initiation). This duration is **669 days**. There are no other periods of A-Time to consider in this case because no Appeal Brief was filed and no Request for Continued Examination was filed so the B-time period, as explained below, never stopped accruing after it initiated.

B-Time Calculation

The time period set forth under 37 C.F.R. 1.703(b), B-Time, allows for 3 years pendency of an application. In the instant case, this is represented by the duration between 9/25/2006 (3 years from filing) and 3/6/2009 (Mailing of Notice of Allowance). This time period represents 893 days. Note, according to 37 C.F.R. 1.702(e) the term of the patent shall be adjusted if the delays were caused by successful appellate review. Here, the Pre-Appeal conference caused prosecution to be reopened and that was the last action prior to issuing the Notice of Allowance. Therefore, the B-Time never stopped accruing after it initiated and the B-Time is **893 days**.

Conclusion

A-Time of 694 days plus B-Time of 893 days minus 56 days results in the correct calculation for PTA being 1531 days. Applicant respectfully requests that the PTA be adjusted to this number for the reasons stated above.

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Respectfully submitted,

May 26, 2009
Date

/William M. Hubbard/
William M. Hubbard
Reg. No. 58,935

**WONG, CABELLO, LUTSCH,
RUTHERFORD & BRUCCULERI, L.L.P.**
20333 State Highway 249, Suite 600
Houston, TX 77070

832/446-2400
832/446-2424 (facsimile)
wcpatent@counselip.com